

## REMARKS

In the Office Action mailed May 23, 2008 from the United States Patent and Trademark Office, claims 1, 3-10, 12 and 13 under 35 U.S.C. 112, first paragraph; claims 1, 3-10, 12 and 13 were rejected under 35 U.S.C. 112, second paragraph; claims 1, 3-10, 12 and 13 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,070,813 ("Jensen") in view of U.S. Patent No. 6,159,443 ("Hallahan") in further view of U.S. Patent No. 6,436,449 ("Gidlund"). Accordingly, Applicant respectfully submits the following.

### Rejections Under 35 U.S.C. §112

Claims 1, 3-10, 12 and 13 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the pending Action indicates that the phrase "percent by volume" is not supported in the specification as originally filed. Accordingly, Applicant has amended independent claim 1 to read, "administering a pre-determined dose of processed *Morinda citrifolia* juice to a patient at a concentration percentage of 2.31." Applicant respectfully requests that the pending written description rejection over the use of the phrase "percent by volume" be withdrawn at this time.

The pending Action indicates that the claims lack sufficient support in the originally filed written description because the term "inhibit" is not described in such a way to convey to the reader that the Applicant had possession of the invention at the time of filing because the term "inhibit" reads on the preventing of COX-1 and COX-2. Applicant respectfully notes that the claims do not indicate exactly the amounts of inhibition, or that complete inhibition would be accomplished. Rather the claims are drawn to a method for selectively inhibiting COX-2 relative to COX-1 by administering a specified concentration of a *Morinda citrifolia* juice product. The concept of selective inhibition finds support in the specification as originally filed. In particular,

Example 1 of the originally filed specification indicates that biochemical assays indicated that a concentration of 2.31% inhibited COX-1 by 20% and COX-2 by almost 60%, while a concentration of 10% *Morinda citrifolia* juice inhibited COX-1 approximately 83% and inhibited COX-2 approximately 84%. *Specification*, page 15, lines 1-5. The specification further indicates that at greater concentrations the selective COX-2 inhibition properties experienced by administering *Morinda citrifolia* juice are sensitive or related to dosing. *Secification*, page 15, lines 5-15. Accordingly, the concept of inhibiting COX-2 relative to COX-1 is described and supported in the specification as originally filed, and Applicant respectfully requests that the §112 rejection be withdrawn at this time.

Claims 9, 10, 12 and 13 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. In particular, the pending Action indicates that methods for treating pain and inflammation are not enabled by administration of 2.31% *Morinda citrifolia* juice. Applicant has amended the preamble of independent claims 9 and 12 to read, “a method for selectively inhibiting COX-2 relative to COX-1 comprising the steps of...” Accordingly, Applicant respectfully requests that the enablement rejection of claims 9, 10, 12 and 13 be withdrawn at this time.

### **Rejections Under 35 U.S.C. §103**

Claims 1, 3-10, 12 and 13 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,070,813 (“Jensen”) in view of U.S. Patent No. 6,159,443 (“Hallahan”) in further view of U.S. Patent No. 6,436,449 (“Gidlund”). However, Jensen and Gidlund do not qualify as art that may be cited against the present application. Accordingly, Applicant respectfully request that the rejections under 35 U.S.C. §103 be withdrawn at this time.

35 U.S.C. §103(c) provides that, “[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.” Jensen was subject to an obligation of assignment to the same entity as the present application at the time the claimed invention was made. Accordingly, Jensen is not art that may be cited against the present application, and Applicant respectfully requests that the rejections under 35 U.S.C. §103 over Jensen be withdrawn at this time.

Gidlund is not a disclosure that can be cited as prior art against the present application. Gidlund’s priority date is August 20, 2002 and depends from a provisional application filed March 2, 2000. The present application was filed December 4, 2001 and claims priority to U.S. Provisional Application No. 60/251,416 to Chen Xing Su et al., filed December 5, 2000, entitled “COX-1 and COX-2 Inhibition Study on TNJ.” Attached here with please find an affidavit executed pursuant to Section 1.131 indicating that the present application was reduced to practice prior to the effective date of the Gidlund reference. Consequently, Gidlund is not a disclosure that can be cited as prior art against the present application, and Applicant respectfully requests that the rejections under 35 U.S.C. §103 over Gidlund be withdrawn at this time.

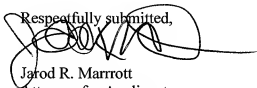
Further, Applicant respectfully submits that Gidlund fails to teach the claim limitations cited in the present application because: 1) Gidlund does not teach administering low doses that produce selective COX-2 inhibition; and 2) Gidlund teaches a method for treating tinnitus, not method for treating pain through selective COX-2 inhibition. Accordingly, Applicant respectfully requests that the §103 rejections be withdrawn at this time.

### CONCLUSION

Applicants submit that the claims are now in condition for allowance. Accordingly, Applicants request favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this 22 day of August, 2008

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Jarod R. Marrott', is written over the text 'Respectfully submitted,'.

Jarod R. Marrott  
Attorney for Applicant  
Registration No. 54,294

KIRTON & McCONKIE  
1800 Eagle Gate Tower  
60 East South Temple  
Salt Lake City, Utah 84111  
Telephone: (801)321-4814  
Facsimile: (801)321-4893

JRM  
Doc#1062088